IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Curry et al.	
Application No.: 09/683,706 (CONF 6456)	Group Art Unit: 2194
Filed: 3/24/2006	Examiner: Van H. Nguyen
Title: Integration of audio or video program with application program	
Attorney Docket No.: 1049.001US1	

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO NON-COMPLIANT APPEAL BRIEF

This filing is made in response to the Notification of Non-Compliant Appeal Brief mailed on July 30, 2007. Therefore, Applicant submits herewith a revised Appeal Brief, along with a one-month extension of time fee. No new substantive arguments, and so on, have been added to this revised Appeal Brief.

The Examiner gave two reasons why the previously provided appeal brief was non-compliant. First, he said that the "brief contains an inappropriate heading, 'Grouping of Claims,' [which] is no longer required by 37 CFR 41.7(c)." Applicant <u>strongly disagrees.</u> 37 CFR 41.7(c)(vii) states that:

> For each ground of rejection applying to two or more claims, the claims may be argued separately <u>or as a group.</u> . . . **Claims argued as a group shall be placed under a subheading identifying the claims by number.**

This is exactly what Applicant has done herein – under the "<u>Argument</u>" section heading is the subheading "<u>*Grouping of claims 1-20.*</u>" <u>Applicant is following the requirements of 37 CFR 41.7(c)(vii) to the strict letter! The Examiner cannot say that "grouping of claims" is no longer required under 37 CFR 41.7(c), where 37 CFR 41.7(c)(vii) specifically says that claims argued as a group "shall be under a subheading identifying the claims by number."</u>

Second, the Examiner has stated that the independent claims are not mapped separately to the specification by page and line number, paragraph number, or to the drawings, if any.

Applicant respectfully disagrees, but to make this mapping even clearer, has revised the Appeal Brief herein.

Should there be any further questions regarding the Appeal Brief, the Examiner is encouraged to contact Michael Dryja, Applicant's representative, at the phone number listed below. **The present response is the THIRD response to a notice of non-compliant appeal brief, and Applicant feels that the Examiner is unduly delaying permitting the present patent application from going before the BPAI. Should there be any further non-compliance, the Examiner really should *CALL* Applicant's representative so that there will not be any further delay; otherwise, Applicant is considering filing a petition to the Director indicating that the Examiner is abusing his authority by preventing the present patent application from being properly considered before the BPAI.** A one-month extension is being filed in conjunction with this response.

Respectfully Submitted,

August 29, 2007
Date

Michael Dryja, Reg. No. 39,662
Attorney/Agent for Applicant(s)

Michael Dryja, Esq.
Law Offices of Michael Dryja
1474 N Cooper Rd #105-248
Gilbert, AZ 85233

tel: 425-427-5094
fax: 425-563-2098

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APPEAL BRIEF

This Appeal Brief is organized in accordance with the requirements set forth in 37 CFR 41.37(c).

Real party in interest

The real party in interest in this patent application is Talkway, Inc., of Fremont, Calif. All the applicants have assigned their rights in the patent application to Talkway.

Related appeals and interferences

There are no related appeals or interferences to the present patent application.

Status of claims

Claims 1-20 are pending in the patent application. Claims 1, 12, and 19 are independent claims, from which the remaining pending claims ultimately depend. All the claims stand rejected, as summarized in the single issue presented for appeal, below.

Status of amendments

Amendments were made to claims 1, 12, and 14-19 during the course of examination. All of these amendments were entered by the Examiner in various Office Actions. As such, there are

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no non-entered amendments pending to the claims. <u>As to the status of any amendments filed subsequent to the final rejection of the claims, no such amendments were filed.</u>

Summary of claimed subject matter

There are three independent claims, claims 1, 12, and 19, pending in the present patent application.

Independent claim 1

As per independent claim 1, claim 1 is directed to a "system." (element 100 of FIG. 1; para. [0019]) This system includes "an operating system" (element 102 of FIG. 1; para. [0019]) and "an application program running on the operating system" (element 104 of FIG. 1; paras. [0019]-[0020]) The system further includes "an audio or video program running on the operating system." (element 106 of FIG. 1, paras. [0019], [0021])

Furthermore, the "audio or video program" (element 106 of FIG. 1; and, element 400 of FIG. 4) is "*separate from but integrated with* [an] application program," (note in FIG. 1, audio or video program 106 is separate from application program 104; see also paras. [0024], [0034] et seq., and [0042] et seq. as to integration; see also paras. [0050] et seq. for an example) "such that in one embodiment the application program *is unaware that the audio or video program has been integrated*" with the application program. (Claim 1; see para. [0024]) As such, "a user of the application programs interacts with the audio or video program as though the audio or video program were part of the application program." (Claim 1; see, e.g., para. [0051])

Independent claim 12

As per independent claim 12, claim 12 is directed to a "method." (element 300 of FIG. 3; para. [0029]) The method "detect[s] when an even related to a predetermined application program occurs." (element 304 of FIG. 3; para. [0029]) The method then performs an action "in response to detection when the event has occurred." (Para. [0029]) This action is that the "audio

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or video program present[s] one or more audio or video controls for use in conjunction with . . . the application program, such that the audio or video program . . . *is integrated with* the . . . application program" (see, e.g., paras. [0026-0029] for an example of such controls providing such integration) but is "*separate from* the . . . application program." (Claim 12; see, e.g., program 106 is separate from program 104 in FIG. 1)

Independent claim 19

As per independent claim 19, claim 19 is directed to a "computer-readable medium having instructions stored thereon for an audio or video computer program." (element 400 of FIG. 4 shows such a computer program; see also para. [0030] that describes that this program can be stored on a computer-readable medium) Claim 19 includes "means for detecting when an event related to a predetermined application program occurs." (element 402 of FIG. 4; para. [0030]) Claim 19 also includes "means for presenting one or more audio or video controls for use in conjunction with the predetermined application program." (element 404 of FIG. 4; para. [0030])

Now, this latter means "present[s] one or more audio or video controls for use in conjunction with the predetermined application program," specifically "such that the audio or video program . . . *is integrated with* the . . . application program" (see, e.g., paras. [0026-0029] for an example of such controls providing such integration) but is "*separate from* the . . . application program." (Claim 19; see, e.g., program 106 is separate from program 104 in FIG. 1)

Further notes regarding all independent claims 1, 12, and 19

The patent application as originally filed further provides some meaning as to what it means that the audio or video program of the invention is integrated with but separate from an application program, as per independent claims 1, 12, and 19, as follows.

> In one embodiment, the application program 104 is unaware that the audio
> or video program 106 has been integrated therewith. This generally and in a non-
> limited manner means that the application program 104 has not been developed a
> priori with the integration of the audio or video program 106 in mind, and also
> does not operate with knowledge that the audio or video program 106 has been

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integrated therewith. Thus, the program 104 is not specifically modified to allow integration of specifically the audio or video program 106. Furthermore, a user of the application program 104 interacts with the audio or video program 106 as though the audio or video program 106 were part of the application program 104. That is, the user may or may not be aware that the audio or video program 106 is actually external to the application program 104.

In another specific embodiment, the application program is specifically unaware that the audio or video program 106 has been integrated therewith. This means that the application program 104 may be generally aware that the audio or video program 106 has been integrated therewith. That is, some application programs may have extension mechanism . . . that allow for extensibility of the application programs. As such, the application programs may be generally aware that other programs may be added thereon. However, the application program 104 is still specifically unaware that the audio or video program 106 has been integrated therewith.

(Paras. [0024]-[0025])

The patent application as originally filed also provides examples of integration of an audio or video program with (but separate from) an application program, which are useful in understanding what such integration of claims 1, 12, and 19 can mean, as follows.

Examples of integration of the audio or video program 106 with the application program 104 are shown in FIGs. 2A and 2B. In FIG. 2A, the window 202 has been created by the application program 104 through the OS 102. The window 202 includes toolbar buttons 204 that are part of the application program 104 itself. However, the window 202 also includes toolbar buttons 206 that are added by the audio or video program 106 through the OS 102, and that relate to functionality provided by the audio or video program 106 itself. That is, the application program 104 is not aware that the audio or video program 106 has added the toolbar buttons 206 to the window 202. When the user clicks on any of the toolbar buttons 206, the resulting functionality is controlled by the audio or video program 106, and not by the application program 104.

. . . .

In FIG. 2B, the window 252 has been created by the application program 104 through the OS 102, whereas the window 254 has been created by the audio or video program 106 through the OS 102. The audio-or-video window 254 is related to the application window 252 in that tasks performed in the audio-or-video window 254 relate to the application window 252 in some way. For example, audio or video recorded by the user through the window 254 may be added to the content of the window 252, such as an email, a word processing

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document, and so on. As another example, the content of the window 252 may include audio or video, or a reference to audio or video, that is played back in the window 254.

(Paras. [0026]-[0028])

The patent application as originally filed finally provides a good summary of the advantages of the claimed invention of claims 1, 12, and 19, as follows.

> Integration of an audio or video program is provided even into an existing application program, such as an email program. Audio or video is thus easily incorporated into emails, and emails having audio or video can be easily played back, even for unsophisticated users. The user preferably interacts with the audio or video program as if it were part of the application program itself, and therefore does not have to perform complicated tasks to add audio or video into the application, or playback audio or video that has already been incorporated.

(Para. [0009])

Grounds of rejection to be reviewed on appeal

For the purposes of this appeal, there is a single issue: whether the claimed invention is unpatentable over (i.e., obvious over) Budge (US Pat. No. 6,564,248) in view of Bates (US Pat. No. 6,721,781) under 35 USC 103(a). Claims 1-2, 8-14, and 19-20 have been rejected on this basis. The other pending claims 3-7 and 15-18 have been rejected under 35 USC 103(a) as being unpatentable over Budge in view of Bates, and further in view of Poreh (US Pat. No. 5,889,518). However, because claims 3-7 and 15-18 are dependent claims depending from independent claims rejected over Budge in view of Bates, insofar as the independent claims are patentable over Budge in view of Bates, dependent claims 3-7 and 15-18 are also patentable. That is, Applicant is contesting herein the rejection of the independent claims in particular as to Budge in view of Bates, such that the patentability of all the claims rises and falls with the patentability of the independent claims at to Budge in view of Bates, insofar as this appeal is concerned.

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Argument

Groupings of claims 1-20

       For purposes of this appeal only, Applicant groups all pending claims 1-20 within a single group, and selects claim 1, as representative of these claims. Claim 1 reads as follows (all the claims are listed at the end of this brief):

1.   A system comprising:

      an operating system;

      an application program running on the operating system; and,

      an audio or video program running on the operating system, the audio or video program separate from but integrated with the application program such that the application program is unaware that the audio or video program has been integrated therewith,

      such that a user of the application program interacts with the audio or video program as though the audio or video program were part of the application program.

      Applicant submits that the claimed invention, as exemplarily represented by claim 1, is not rendered unpatentable over Budge in view of Bates for three separate and independent reasons. First, Bates does not disclose certain limitations of the claimed invention as indicated by the Examiner. Second, Budge does not disclose certain limitations of the claimed invention as indicated by the Examiner. Third, Budge is not properly combined with Bates under 35 USC 103(a). Each of these reasons is now discussed in detail in turn. Applicant notes that the Board only has to agree with any one of these reasons in order to conclude that the claimed invention is patentable.

1) Bates does not teach certain limitations of the invention as indicated by the Examiner

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In the Office Actions of June 27, 2005, and of December 30, 2005, the Examiner indicated that:

> Budge does teach the predetermined application program and the audio or video program. Budge, however, does not explicitly teach the programs separate but integrate [sic]. Bates teaches the programs separate but integrate [sic].

(June 27, 2005, Office Action, p. 3, paras. b-c; December 30, 2005, Final Office Action, p. 3, paras. b-c) Because the Examiner has specifically relied upon Bates in teaching separate but integrated programs, Applicant discusses Bates in particular to show why Budge in view of Bates does not disclose an audio or video program being integrated with but separate from a predetermined application program, as in the claimed invention. That is, Applicant is very much cognizant that the instant rejection was proffered under 35 USC 103(a) over Budge in view of Bates; Applicant discusses Bates alone in this section of the Appeal Brief because the Examiner himself relied upon Bates alone in teaching certain aspects of the claimed invention, and Applicant disagrees with the Examiner's interpretation of Bates.[1]

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[1]   Applicant initially notes that the Examiner has ignored throughout examination this argument of Applicant's. The argument that Bates does not disclose certain limitations of the invention was presented by Applicant in the Office Action Response of September 23, 2005. (See pp. 9-11) In the Final Office Action of December 30, 2005, however, the Examiner did not separately consider this independent and separate basis of patentability, only indicating that Applicant's arguments "have been fully considered." (P. 8, para. 23) However, the Examiner incorrectly stated that "Applicant argued in substance that Budge does not teach a predetermined application program and an audio or video program that is separate from the predetermined application program," when in fact Applicant *also* argued that *Bates* does not teach certain limitations of the invention. (December 30, 2005, Final Office Action, p. 8, para. 24)

Applicant reminded the Examiner in the Final Office Action Response of February 24, 2006 that:

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> In the previous office action response, Applicant explained in considerable detail why Bates does not teach an application program being separate but integrated with the audio or video program, as to which the claimed invention is limited, such that this was an additional and separate reason why Budge in view of Bates does not render the claimed invention unpatentable. . . . .
>
> In the Final Office Action [of December 30, 2005], however, the Examiner did not even consider this separate and independent basis of patentability. . . . .
>
> The Examiner must consider all of Applicant's arguments, and not the . . . one of Applicant's arguments. . . . The Examiner simply ignored a key argument that Applicant presented. Therefore, Applicant requests that the Examiner consider this argument in detail, as it is a separate and basis for patentability.

(February 24, 2006, Final Office Action Response, pp. 11-12) However, in the Advisory Action of March 24, 2006, the Examiner again failed to separately consider this independent and separate basis of patentability, again only indicating that Applicant's arguments "have been fully considered" and that "Applicant argued in substance that an operation system can not be peoperly [sic] construed as a predetermined application program," when in fact Applicant also argued that Bates does not teach certain limitations of the invention. (March 24, 2006, Advisory Action, p. 2, paras. 1-2)

While the Examiner's refusal to consider all of Applicant's arguments in detail, instead just focusing on one of the three arguments Applicant presented throughout the examination process, is perhaps not controlling on this Board, it does speak to and reflect the Examiner's general attitude toward examination of Applicant's invention. That is, it is difficult for Applicant to take what arguments the Examiner has made at face value when the Examiner has chosen to ignore all of Applicant's arguments, and in this vein, Applicant respectfully requests that the Board also consider the Examiner's failure to respond to all of Applicant's arguments when considering the Examiner's arguments.

In general, the patent application examination process abjectly fails when an examiner chooses not to consider all of an applicant's arguments. As stated in the Final Office Action Response of February 24, 2006:

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The Examiner has specifically relied upon FIG. 3 of Bates and its associated text as disclosing a program that is separate from but integrated with another program. The relevant portion of the discussion of FIG. 3 in Bates reads as follows.

> Browser 322 may be integrated into operating system 321, **_OR_** may be a separate application program.

(Col. 7, ll. 6-8) As an initial matter, Bates teaches two different embodiments. First, the browser 322 may be integrated into the operating system 321. Second, the browser may be a separate application program, separate from the operating system 321.

By comparison, the claimed invention is limited to the "audio or video program . . . separate from but integrated with the predetermined application program" That is, the claimed invention is limited to the audio or video program being _BOTH_ integrated with the predetermined application program _AND_ separate from the predetermined application program. Bates, however, does not teach this limitation of the claimed invention. Rather, Bates teaches that _EITHER_ the browser 322 may be integrated into the operating system 321, _OR_ the browser 322 may be an application program separate from the operating system 321. Therefore, there is no way Bates teaches this aspect of the claimed invention, such that Budge in view of Bates does not render the claimed invention unpatentable.

In sum, whereas Bates discloses that the browser 322 may be integrated into the operating system 321 _OR_ that the browser 322 may be a separate application program, the claimed invention is limited to the audio or video program being _BOTH_ integrated with the predetermined application program _AND_ separate from the predetermined application program. Stated another way, Bates teaches A _OR_ B, whereas the claimed invention is limited to A _AND_ B. Therefore,

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At great expense, Applicant formulated a complete response to the previous office action. The Examiner simply ignored a key argument that Applicant presented.

(P. 12) It thus has been an arduous and difficult road for Applicant in reaching this Appeal, since Applicant has never had the benefit of the Examiner's complete attention in this patent application.

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Bates does not teach this aspect of the claimed invention, and Budge in view of Bates does not render the claimed invention unpatentable.

Furthermore, the Examiner committed another misinterpretation of Bates in rejecting the claimed invention over Budge in view of Bates. The claimed invention is limited to an application program and an audio or video program, where the latter program is separate from but integrated with the former program. However, as can be appreciated by those of ordinary skill within the art, an audio or video program is another application program. Thus, the claimed invention is limited to two application programs that are separate from but integrated with one another: a first application program referred to as an application program, and a second application program referred to as an audio or video program.

However, Bates discloses its integration *OR* separation as to an application program, the browser 322, and the operating system 321, which is *not* an application program. Therefore, Bates also cannot disclose the claimed invention's integration *AND* separation of two application programs, because it does not disclose two application programs. Rather, Bates discloses one application program, the browser 322, and a non-application program, the operating system 321. One of ordinary skill within the art can readily appreciate that an operating system is most definitely not an application program.[2] Therefore, Bates further does not teach this aspect of the claimed invention, because it discloses two different types of computer programs – an application program and an operating system – whereas the claimed invention is limited to two application programs. For this reason, too, Budge in view of Bates does not render the claimed invention unpatentable.

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[2]   Applicant presents a fuller discussion as to why an operating system is not an application program in the next section of this Appeal Brief, in which it is argued that Budge does not disclose certain limitations of the invention as indicated by the Examiner. Therefore, Applicant refers the Board to this more detailed discussion as to why an operating system is not an application program in considering the argument presented in this section of the Appeal Brief, that Bates does not disclose certain limitations of the invention as indicated by the Examiner.

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2) Budge does not disclose certain limitations of the invention as indicated by the Examiner

In the Office Actions of June 27, 2005, and of December 30, 2005, the Examiner has relied upon Budge as teaching an audio or video program and an application program. For instance, the Examiner has noted that "Budge does teach the . . . application program and the audio or video program." (June 27, 2005, Office Action, p. 3, para. b; December 30, 2005, Final Office Action, p. 3, para. b) Because the Examiner specifically relies upon Budge in teaching this aspect of the claimed invention, Applicant discusses Budge in particular to show why Budge in view of Bates does not disclose this aspect of the claimed invention. That is, Applicant is very much cognizant that the instant rejection was proffered under 35 USC 103(a) over Budge in view of Bates; Applicant discusses Budge alone in this section of the Appeal Brief because the Examiner relied upon Budge alone in teaching certain aspects of the claimed invention, and Applicant disagrees with the Examiner's interpretation of Budge.

The Examiner specifically indicates in paragraph 26 on page 8 of the Final Office Action of December 30, 2005, that the predetermined application program of Budge is the "operating system software" whereas the audio or video program of Budge is the "video e-mail software 50."[3] However, the claimed invention is limited to a predetermined application program, and an audio or video program that is *separate from* the predetermined application program, where the audio or video program is the program presents the audio or video controls.

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[3]   It is noted that this argument of the Examiner is different than the interpretation the Examiner proferred in the previous Office Action of June 27, 2005, in which the audio or video program of Budge was recited as being the video e-mail software 50. It has thus been difficult for Applicant to properly assess and respond to the Examiner's rejections when he did provide a detailed response to Applicant's arguments, since the Examiner kept interpreting the prior art references differently vis-à-vis the claimed invention during the course of examination. Applicant openly wonders why the Examiner felt it necessary to interpret Budge one way in the Office Action of June 27, 2005, and another way in the Final Office Action of December 30, 2005.

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Applicant asserts that an operating system, however, cannot be properly construed as a predetermined application program consistent with the claimed invention. It is true that the Examiner has an obligation to interpret the claims as broadly and as reasonably as possible during prosecution. However, it is noted that the interpretation of the claims is to be accomplished to provide the claims with their broadest and most reasonable meaning, consistent with the ordinary and accustomed meaning of the claim language to those of ordinary skill within the art. That is, the general rule of claim interpretation is that terms in a claim are to be given their ordinary and accustomed meaning. (Renishaw PLC v. Marpos Societa per Azioni, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998); York Prods., Inc. v. Central Tractor Farm & Family Ctr., 99 F.3d 1568, 1572, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996))

To support Applicant's contention that an operating system is not properly, broadly, and generally considered an application program, Applicant turns to two pieces of evidence presented in a Form 1449 co-filed with the Office Action Response of February 24, 2006. First, the www.techtarget.com online dictionary of operating system states the following.

> An operating system (sometimes abbreviated as "OS") is the program that, after being initially loaded into the computer by a boot program, manages *all the other programs* in a computer. *The other programs* are called *applications or application programs.* The application programs make use of the operating system by making requests for services through a defined application programming interface (API).

This definition of *operating system* makes it clear that the ordinary and accustomed meaning of the terminology *operating system,* to those of ordinary skill within the art, is such that it is not considered an *application program.* Rather, an operating system is a program that manages *all the other programs* running, which are called *application programs.* Therefore, Budge cannot be considered as teaching a predetermined application program as to which the claimed invention is limited, as broadly and reasonably interpreted, such that Budge in view of Bates does not teach all the claim limitations, and thus does not render the claimed invention unpatentable.

Second, consider the Computer Desktop Encyclopedia definitions of system software and application program. The definition of system software is as follows.

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> Programs used to control the computer and develop and run application programs. It includes operating system . . . . *Contrast with* <u>application program</u>.

Furthermore, the definition of application program is as follows.

> Any data entry, update, query or report program that processes data for the user . . . . *Contrast with* <u>system program</u>.

The diagrams associated with these two definitions are also informative. In the first diagram provided in relation to the definition of an application program, the operating system is clearly shown as being separate from application programs. In the second diagram provided in relation to the definition of system software, the system software is seen as including the operating system, which is separate from the application software. Thus, an operating system is different than an application program, insofar as an operating system is to be *contrasted with* an application program (and vice-versa), such that the two types of programs are different. Therefore, Budge cannot be considered as teaching a predetermined application program as to which the claimed invention is limited, as broadly and reasonably interpreted, such that Budge in view of Bates does not teach all the claim limitations, and thus does not render the claimed invention unpatentable.

Now, the Examiner in the Advisory Action of March 24, 2006, has attempted to make the argument that "Budge's operating system software is software run by the operating system, not the operating system itself." (P. 2, para. 3) However, this interpretation that "operating system software" is software run by the operating system and not the operating system itself fails when you actually consider what Budge says:

> A preferred PC for the sending system is a conventional "wintel" configuration based on Intel Corporation's family of microcomputer circuits, such as the 486 and PENTIUM family and Microsoft Corporation's WINDOWS *operating systems* such as WINDOWS 3.1, WINDOWS 95, or WINDOWS NT. . . . . In addition to *operating system software*, the sending system PC 10 executes video e-mail software 50 which provides for the creation of video e-mail messages and the transfer of those messages to a conventional e-mail client, such as EUDORA PRO 3.0 from Qualcomm Inc., San Diego, Calif.

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(Col. 3, ll. 28-42) (Emphasis added) It clear from this excerpt of Budge that the terminology "operating system" and "operating system software" are synonymous, and the latter does not mean "software running on the operating system," as the Examiner has posited. That is, Budge says you can use a standard PC for the sending system that uses a version of Microsoft's Windows operating system, and then says that "in addition to [this] operating system software," the sending system executes video e-mail software. This is definitely the more reasonable and accurate way to interpret Budge in the eyes of one of ordinary skill within the art.

For example, you can ask someone of ordinary skill within the art "what operating system software are you running?" They may answer "Microsoft Windows XP," or "Linux," or "Apple's MacOS." That is, they will answer by identifying which operating system they are running. They are not going to answer "Microsoft Word" (or another word-processing program), "Microsoft Excel" (or another spreadsheet program), "Adobe Acrobat," and so on, which are all examples of software run by an operating system. That is, software run by an operating system is not operating system software. Software run by an operating system includes word-processing software, spreadsheet software, and other types of software, but are not considered "operating system software" as argued by the Examiner. If you go to your local computer store and ask a sales associate to point you to where they have "operating system software," he or she is going to show you the aisle where they have Microsoft Windows XP, Apple's MacOS, and so on, and not the aisle where they have word-processing software, spreadsheet software, and so on, which are all software that runs on an operating system.[4]

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[4]   Applicant believes that the Examiner was forced into this box of arguing that operating system software is not the operating system itself due to his flip-flopping in trying to come up with something in Budge that corresponds to the application program of the claimed invention, as noted in footnote 1 above. For instance, in the Office Action of June 27, 2005, the Examiner specifically indicated in paragraph 5.a.i. on page 3 thereof that the application program of Budge is the "video e-mail software 50," in contradistinction to his later argument in the Final Office Action of December 30, 2005, that the application program of Budge is "operating system

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software." Applicant in response to the Office Action of June 27, 2005, noted that the claimed invention includes an application program, and a *separate* audio or video program.

In that response, Applicant noted that if the video e-mail software 50 is the claimed invention's application program in Budge, then there has to be a *different* program in Budge – the claimed invention's audio or video program – that presents the audio or video controls for use in conjunction with the application program. This is because the claimed invention's predetermined program is *separate from* the audio or video program. However, Budge does not disclose a program *separate from* the application program (i.e., the video e-mail software 50) presenting the audio or video controls. Rather, the controls of FIG. 6 in Budge that the Examiner equated in the Office Action of June 27, 2005, to the audio or video controls of the claimed invention are actually provided by the video e-mail software 50 – i.e., the program that the Examiner had already equated to the application program of the claimed invention.

However, under this earlier interpretation of Budge by the Examiner, Budge would have to have a *separate* program – the claimed invention's audio or video program – as presenting audio or video controls in conjunction with the application program (i.e., the video e-mail software 50). But in Budge, a video-email recorder component of the same video e-mail software 50 (i.e., the application program) presents the audio or video controls. Thus, whereas in the claimed invention there is an application program and an audio or video program, where it is the latter presents audio or video controls, in Budge, if the video e-mail software 50 is the application program, then it is the program that presents the audio or video controls – not a separate audio or video program as in the claimed invention.

Applicant reprises all of this earlier argument to again buttress the point that the Examiner has flip-flopped what he is regarding as in Budge the application program of the claimed invention. First, the application program of the claimed invention was the audio or video software in Budge. Second, the application program of the claimed invention was the operating system in Budge. Third, the application program of the claimed invention was (and is) the operating system software in Budge, even though the terminology "operating system software" is not different than,

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3) Budge is not properly combined with Bates under 35 USC 103(a)

In the Office Actions of June 27, 2005, and of December 30, 2005, the Examiner's stated

reasons for combining Budge with Bates is as follows.

> It would have been obvious to a person of ordinary skill in the art at the
> time the invention was made to combine the teachings of Bates and Budge because
> Bates's teaching would have provided the capability for accommodating the
> combination of the two programs within a single computing device, and therefore,
> prov[id]ing compatibility for Budge's system.

(June 27, 2005, Office Action, p. 4, para. d; December 30, 2005, Final Office Action, p. 3,

para. d) These stated reasons for combining Budge with Bates, however, do not make sense on a

number of different levels, such that in actuality there is no reason within the prior art to combine

Budge with Bates.[5]

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and is another way of saying, "operating system." Applicant has had to work overtime just to

keep up with all of the Examiner's different ways of trying to force the square peg of the prior art

into the round hole of the claimed invention!

[5]   Applicant initially notes that the Examiner has ignored throughout examination this

argument of Applicant's as well. The argument that Budge is not properly combined with Bates

was presented by Applicant in the Office Action Response of September 23, 2005. (See pp. 12-

13) In the Final Office Action of December 30, 2005, however, the Examiner did not separately

consider this independent and separate basis of patentability, only indicating that Applicant's

arguments "have been fully considered." (P. 8, para. 23) However, the Examiner incorrectly

stated that "Applicant argued in substance that Budge does not teach a predetermined application

program and an audio or video program that is separate from the predetermined application

program," when in fact Applicant *also* argued that *Budge is not properly combined with Bates.*

(December 30, 2005, Final Office Action, p. 8, para. 24)

Applicant reminded the Examiner in the Final Office Action Response of February 24,

2006 that:

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First, the Examiner has stated that "Bates's teaching would have provided the capability for accommodating the combination of the two programs within a single computing device." However, Budge *already discloses* using the combination of two programs within a single computing device, such as the single computing device 2 or 4 of FIG. 1 thereof. That is, Budge already teaches using the combination of a predetermined application program (e.g., conventional e-mail client software, in col. 3, ll. 40-41) and an audio or video program within a single computing device (e.g., video e-mail software 50, in col. 3, l. 37). There is no reason to combine Bates with Budge to achieve this functionality, because Budge already provides this functionality itself. For this reason alone, there is no motivation within the prior art to combine Bates with Budge, such that combining Budge with Bates is improper.

Second, the Examiner states that "compatibility" for Budge's system would be provided by combining Budge with Bates. This statement is incorrect, because Budge is completely

> In the previous office action response, Applicant also explained in considerable detail why Budge is not combinable with Bates, and this was also another separate reason why Budge in view of Bates does not render the claimed invention unpatentable. . . . .
> The Examiner also ignored this separate and independent basis of patentability in the Final Office Action [of December 30, 2005]. The Examiner does not particularly acknowledge having considered it and does not particularly respond to it. . . . .

(February 24, 2006, Final Office Action Response, pp. 12-13) However, in the Advisory Action of March 24, 2006, the Examiner again failed to separately consider this independent and separate basis of patentability, again only indicating that Applicant's arguments "have been fully considered" and that "Applicant argued in substance that an operation system can not be peoperly [sic] construed as a predetermined application program," when in fact Applicant also argued that Budge is not properly combined with Bates. (March 24, 2006, Advisory Action, p. 2, paras. 1-2)

The Examiner's refusal to consider this argument of Applicant in detail also buttresses the conclusion that Applicant has never had the benefit of the Examiner's complete attention in this patent application.

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"compatible" in and of itself. The predetermined application program and the audio or video program of Budge are taught and disclosed within Budge as running on the computing device, or system, 2 or 4 of FIG. 1. No extra "compatibility" is needed or gained by combining Budge with Bates. Because Budge is completely "compatible" by itself, in that the application program and the audio or video program of Budge already can run in combination on the system of Budge without any problems, there is no reason to combine Bates with Budge to achieve this functionality. For this reason, too, there is no motivation within the prior art to combine Bates with Budge, such that combining Budge with Bates is improper.

In sum, Applicant notes the MPEP instructs that "[t]he mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the *desirability* of the combination." (MPEP sec. 2143.01) In the present situation, Bates may very well *be able to be* combined with Budge. However, there is no *reason* within the prior art why such a combination is *desirable*. First, Bates does not provide Budge with the capability for accommodating the combination of the two programs within a single computing device, since Budge already has this capability. Indeed, the Examiner does not state why providing Budge with the capability for accommodating the combination of the two programs within a single computing device is even desirable, as required by the MPEP. Just because Bates *could* provide Budge with such capability does not mean that Budge *should* be "provided" with such capability, especially where Budge already *has* this capability. Second, and similarly, Bates does not provide Budge with "compatibility" for Budge's system, since Budge already has such "compatibility." There is no reason why it is desirable to combine Bates with Budge, such that combining Budge with Bates is improper.

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<u>Conclusion</u>

Applicant believes that the pending claims are in condition for allowance, and requests that they so be allowed, for the reasons described above.

Respectfully Submitted,

<u>November 14, 2006</u>
Date

Michael Dryja, Reg. No. 39,662
Attorney/Agent for Applicant(s)

Michael Dryja, Esq.
Law Offices of Michael Dryja
704 228th Ave NE #694
Sammamish, WA 98074

tel: 425-427-5094
fax: 425-563-2098

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Claims appendix

1.   (previously presented) A system comprising:

        an operating system;

        an application program running on the operating system; and,

        an audio or video program running on the operating system, the audio or video program

separate from but integrated with the application program such that the application program is

unaware that the audio or video program has been integrated therewith,

        such that a user of the application program interacts with the audio or video program as

though the audio or video program were part of the application program.

2.   (original) The system of claim 1, wherein the audio or video program is integrated with

the application program by detecting when an event related to the application program occurs.

3.   (original) The system of claim 2, wherein the audio or video program is further integrated

with the application program by subclassing into a window of the application program.

4.   (original) The system of claim 2, wherein the audio or video program is further integrated

with the application program by hooking into a window of the application program.

5.   (original) The system of claim 1, wherein the audio or video program is integrated with

the application program by employing a customization mechanism of the application program.

6.   (original) The system of claim 1, wherein the audio or video program is integrated with

the application program by employing application programming interfaces (API's) of the

application program.

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7.   (original) The system of claim 1, wherein the audio or video program modifies contents of a window of the application program created through the operating system.

8.   (original) The system of claim 1, wherein the audio or video program runs in a window created through the operating system and related to a window of the application program created through the operating system.

9.   (original) The system of claim 1, wherein the application program comprises one of: an email program, a presentation program, a publishing program, a word processing program, a spreadsheet program, an instant messaging program, a telephony program, and a gaming program.

10.   (original) The system of claim 1, wherein the audio or video program comprises one of: an audio or video player program, an audio or video recorder program, an audio or video player-and-recorder program.

11.   (original) The system of claim 1, wherein the audio or video program comprises one of: an audio-only program, a video-only program, and an audio-and-video program.

12.   (previously presented) A method comprising:
        detecting when an event related to a predetermined application program occurs;
        in response to detecting when the event has occurred,
            an audio or video program presenting one or more audio or video controls for use in conjunction with the predetermined application program, such that the audio or video program encompassing the one or more audio or video controls is integrated with the predetermined application program, the audio or video program being separate from the predetermined application program.

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13.   (original) The method of claim 12, wherein presenting the one or more audio or video controls comprises integrating the one or more audio or video controls within a window of the predetermined application program.

14.   (previously presented) The method of claim 12, wherein presenting the one or more audio or video controls comprises creating an audio or video program window through an operating system in which the one or more audio or video controls are located.

15.   (previously presented) The method of claim 12, wherein presenting the one or more audio or video controls comprises subclassing into a window of the predetermined application program.

16.   (previously presented) The method of claim 12, wherein presenting the one or more audio or video controls comprises hooking into a window of the predetermined application program.

17.   (previously presented) The method of claim 12, wherein presenting the one or more audio or video controls comprises employing a customization mechanism of the predetermined application program.

18.   (previously presented) The method of claim 12, wherein presenting the one or more audio or video controls comprises employing application programming interfaces (API's) of the predetermined application program.

19.   (previously presented) A computer-readable medium having instructions stored thereon for an audio or video computer program comprising:

        means for detecting when an event related to a predetermined application program occurs;

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means for presenting one or more audio or video controls for use in conjunction with the predetermined application program,

such that the audio or video computer program of which the one or more audio or video controls are a part is separate from but integrated with the predetermined application program.

20.   (original) The medium of claim 19, wherein the predetermined application program comprises one of: an email program, a presentation program, a publishing program, a word processing program, a spreadsheet program, an instant messaging program, a telephony program, and a gaming program.

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Evidence Appendix

(No evidence was submitted pursuant to Rules 130, 131, and 132, and therefore, this section is
blank.)

Related Proceedings Appendix

(There are no related proceedings to this patent application, and therefore, this section is blank.)